

REMARKS

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-7 and 23-37 are original and pending in the application.

Rejections Under 35 U.S.C. § 101

Claims 1-7 and 23-37 stand rejected under 35 U.S.C. § 101. The Office states that these claims are directed to non-statutory subject matter.

The Office also offers the following analysis: "The claimed invention is not a computer program per se. It is a series of steps performed on a computer. Evaluating the process there is no pre-computer or post computer activity. The invention merely manipulates abstract idea or solves a purely mathematical problem without any limitation to a practical application. Therefore the claims are non-statutory." *Office Action*, p. 2.

Response to Rejections Under 35 U.S.C. § 101

Applicant respectfully submits that Claims 1-7 and 23-37 recite machines constituting statutory subject matter under 35 U.S.C. §101. Applicant sets forth the legal standard for a rejection under §101, including a case addressing a similar rejection under §101 as that of the instant rejection of Claims 1-7 and 23-37. Through analysis of this case, Applicant will show that the Office's rejection of the instant claims stands in stark disagreement with prevailing law.

1           The Federal Circuit in *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed.  
2 Cir. 1994) held that the following computer-related apparatus claim constituted  
3 statutory subject matter under 35 U.S.C. §101:

4           A rasterizer for converting vector list data representing  
5 sample magnitudes of an input waveform into anti-aliased pixel  
6 illumination intensity data to be displayed on a display means  
comprising:

7           (a) means for determining the vertical distance between the  
8 endpoints of each of the vectors in the data list;  
9           (b) means for determining the elevation of a row of pixels that  
is spanned by the vector;  
10          (c) means for normalizing the vertical distance and elevation;  
and  
11          (d) means for outputting illumination intensity data as a  
12 predetermined function of the normalized vertical distance and  
elevation.

13          In *Alappat*, the Office and a Board addressing the issue on appeal stated  
14 that this claim is not statutory subject matter under §101. The reasons given by  
15 the Board are similar to those given in the instant rejection by the Office of Claims  
16 1-7 and 23-37. The majority decision of the Board stated that it is proper to treat  
17 the above-cited rasterizer claim as if drawn to a method. *See Ex Parte Alappat*, 23  
18 USPQ2d 1340, 1345 (BPAI, 1992). Specifically, the Board held that this claim  
19 amounts to nothing more than a process claim where each of the steps combine to  
20 form a "mathematical algorithm for computing pixel information." *Alappat* at  
21 1539, quoting *Ex Parte Alappat* at 1345. Further, that "when the claim is viewed  
22 without the steps of this mathematical algorithm, no other elements or steps are  
23 found." *Ex Parte Alappat* at 1346. The Board's reasoning is similar to that of the  
24 rejection of instant claims 1-7 and 23-37, where the Office argued that the claimed  
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1 invention is a "series of steps" that "merely manipulates abstract ideas or solves a  
 2 purely mathematical problem." *Office Action*, p. 2.

3 The Federal Circuit overturned the Board. The Circuit stated that the Board  
 4 erred in concluding that this rasterizer claim is nothing more than a process claim.  
 5 *Alappat* at 1540. In deciding that the Board erred, the Circuit relied on the  
 6 language of the claim on its face as well as the claim when read in light of the  
 7 disclosure of the specification. *Id.* The Circuit also analyzed whether the claimed  
 8 subject matter as a whole is a disembodied mathematical concept, which in  
 9 essence represents nothing more than a "law of nature," "natural phenomenon," or  
 10 "abstract idea." *Id* at 1544.

11 Applicant sets forth the analysis performed by the Circuit and then applies  
 12 this analysis to the instant rejection of Claims 1-7 and 23-37.

13 The Circuit relied on 35 U.S.C. §101, entitled "Inventions patentable,"  
 14 which states that: "Whoever invents or discovers any new and useful process,  
 15 machine, manufacture, or composition of matter, or any new and useful  
 16 improvement thereof, may obtain a patent therefor, subject to the conditions and  
 17 requirements of this title". *Emphasis added.* Such statute explicitly provides, in  
 18 unequivocal language, for machines as a statutory category of subject matter for  
 19 which Applicant is entitled to apply for a patent.

20 Following this standard, the Circuit's analysis focused on the claim reciting  
 21 "a rasterizer" and other elements. The Circuit analyzed the language of the claim,  
 22 concluding that the rasterizer claim recites a machine on its face.

23 Applicant establishes below that the subject matter recited in independent  
 24 Claims 1, 23, 29, and 34 recites a machine on its face. Applicant provides  
 25 independent Claims 1, 23, 29, and 34 below for the convenience of the Office.

1      Claim 1 recites an electronic document editor, comprising:

2            • a default event handler to process editing events;

3            • a designer extensibility mechanism to communicate with an extension  
coupled with the editor, the extension being configured to process at least  
one of the editing events; and

4            • wherein the designer extensibility mechanism provides the editing events to  
the extension prior to the default event handler processing the editing  
events.

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7      Claim 23 recites a designer attached to an editor, comprising a pre-event handler  
8      that processes an editing event from the editor before the editor processes the  
9      event.

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11     Claim 29 recites an editor that communicates with a first designer and a second  
12     designer, comprising:

13            • a default event handler; and

14            • an edit designer interface that includes a pre-handle event method to  
process an event before the default event handler processes the event, and a  
post-handle event method to process the event after the default event  
handler has processed the event.

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17     Claim 34 recites an edit designer interface in an extensible editor, comprising:

18            • a pre-handle event method used to send an editing event to a designer  
attached to the editor prior to the editor processing the editing event; and

19            • a post-handle event method used to send the editing event to the designer  
after the editor has processed the editing event.

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1       Claims 1, 23, 29, and 34 all recite either an "editor" or a "designer". These  
2 terms on their face recite a machine—not a process or a series of steps performed  
3 on a computer as argued by the Office.

4       The Circuit also studied the disclosure of the specification in deciding  
5 whether or not the rasterizer claim constitutes a statutory class of subject matter.  
6 The Circuit determined that the rasterizer claim recites a machine based on the fact  
7 that the disclosure describes computer elements that are recited in the claim. The  
8 claim recites means-plus-function elements, though this was not despositive in the  
9 Circuit's analysis. Rather, the Circuit relied on the disclosure to show computer  
10 elements that may be within the scope of the rasterizer claim. Similarly,  
11 exemplary elements are described in the instant specification that, when analyzed  
12 as examples of elements recited in the instant claims, show that the instant claims  
13 recite a machine and not a process.

14       Independent Claims 1, 23, 29, and 34, when read in light of the  
15 specification, clearly and unequivocally recite machines. It is black letter law that  
16 Applicant's claims are to be interpreted in light of the disclosure of the  
17 specification. *North Am. Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571,  
18 1579, 28 USPQ2d 1333, 1339 (Fed. Cir. 1993); and see *Miles Lab., Inc. v.*  
19 *Shandon, Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993).

20       The specification describes examples of subject matter recited in the claims  
21 that are not solely or necessarily a "process" or a "series of steps performed on a  
22 computer" as argued by the Office. Instead, this subject matter recites one or more  
23 machines.

24       Claim 1 recites "an electronic document editor" comprising "a default event  
25 handler", each of which are described and diagrammed as a machine—not as a

1 process or a series of steps performed on a computer. Applicant refers the Office  
2 to examples of an editor and a default event handler in the specification: editor 206  
3 of Figure 2; editor 300 of Figures 3 and 4; editor 600 of Figure 6; editor 700 of  
4 Figure 7; and default event handler 301 of Figures 3 and 4.

5 Claim 23 recites "a designer" attached to "an editor." Applicant refers the  
6 Office to the above-cited examples of an editor and examples of a designer,  
7 namely: designer 216, designer 218, and designer 220 of Figure 2; and designer A  
8 320 and designer B 330 of Figure 4. These exemplary elements are shown and  
9 described as machines—not necessarily just a "series of steps performed on a  
10 computer" as argued by the Office.

11 Claim 29 recites "an editor" that communicates with a "first designer" and  
12 a "second designer," which comprises "a default event handler" and "an edit  
13 designer interface." Applicant refers the Office to the above-cited examples of an  
14 editor, default event handler, and designers, as well as an example of an edit  
15 designer interface such as 304 of Figure 3. All of these exemplary elements are  
16 described and diagrammed as machines.

17 Claim 34 recites "an edit designer interface" in an "extensible editor." Here  
18 again, the specification discloses examples constituting machines—an extensible  
19 editor 206 of Figure 2 and an exemplary edit designer interface 304 of Figure 3.

20 Not only are these elements described as machines by their usage and  
21 diagrammed as machines in the figures, each may also be stored in a computer's  
22 memory. This characteristic, in and of itself, precludes these elements from being  
23 solely or necessarily a process or a series of steps as relied upon by the Office in  
24 rejecting Claims 1-7 and 23-37 under §101.

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Furthermore, the specification provides the following examples of elements recited in Claims 1, 23, 29, and 34 and described as machines that *perform* an action rather than simply *being* an action or step:

Fig. 2 is a block diagram of a computer 200 having a processor 202 and memory 204. An extensible editor 206 stored in the memory 204 includes an event routing controller 208, a designer extensibility mechanism 210, a selection services component 212, and a highlight rendering services component 214. Three designers 216, 218, 220 are also stored in the memory 204. Each of the designers 216 - 220 communicates with the editor 206 via the designer extensibility mechanism 210. Each designer 216 - 220, as shown, also communicates with the selection services component 212 and the highlight rendering component 214. It is noted, however, that a designer 216 - 220 may communicate with only the selection services component 212 or the highlight rendering component 214 or with neither. However, as will become clear in the following discussion, each designer 216 - 220 must attach to the editor 206 through the designer extensibility mechanism 210.

*Specification, p. 12, lines 10-22.*

Thus, an editor 206 is described in Figure 2 and on page 12 of the specification in language permitting the electronic document editor to be: 1) stored in memory; 2) include other elements, namely an event routing controller 208, a designer extensibility mechanism 210, a selection services component 212, and a highlight rendering services component 214; and 3) capable of communicating with designers 216-220. *Id.* These characteristics of this exemplary editor describe a machine—not a series of steps as argued by the Office. A step cannot be stored in memory. A step cannot include machine elements. A step cannot communicate with designers. Thus, the characterization put forth by the Office in rejecting Claims 1-7 and 23-27 is inconsistent with the detailed description.

Like the Office in the instant rejection, the Board in *Alappat* also argued that the claimed subject matter falls within an exception to §101, namely that it is

1 a "mathematical algorithm." See *Alappat* at 1542. In analyzing the Board's  
2 position, the Circuit explained the Supreme Court's holdings on mathematical  
3 subject matter. The Circuit stated that the Supreme Court "never intended to  
4 create an overly broad, fourth category of subject matter excluded from §101."  
5 *Alappat* at 1543. Instead, the Circuit explained that this exception to §101 applies  
6 to abstract ideas that, in and of themselves, are not entitled to patent protection.  
7 The focus in any statutory subject matter analysis must be on the claim as a whole;  
8 it is irrelevant that a claim may contain, as part of the whole, subject matter which  
9 would not be patentable by itself. *Alappat* at 1543, referring to *Diamond v. Diehr*,  
10 450 U.S. 175, 101 S.Ct. 1048 (1981).

11 The Circuit in *Alappat* concluded that the proper inquiry in dealing with the  
12 mathematical subject matter exception of §101 is to determine whether the  
13 claimed subject matter as a whole is a disembodied mathematical concept. In  
14 essence, it must represent *nothing more* than a "law of nature," "natural  
15 phenomenon," or "abstract idea." See *Alappat* at 1544. If the claim represents  
16 more than these, it does not fall within the mathematical subject matter exception  
17 to §101.

18 Applicant submits that the Office has failed to meet the Circuit's standard  
19 in *Alappat* in rejecting Claims 1-7 and 23-37. The Office has failed to show that  
20 each of these claims represents nothing more than a law of nature, natural  
21 phenomenon, or abstract idea. The Office argues that these claims merely  
22 manipulate data or solve a purely mathematical problem without any limitation to  
23 a practical application. This is simply not supported by the claims or examples of  
24 elements in the claims disclosed in the specification.

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1       Claim 1 recites a "default event handler to process editing events," Claim  
2       23 recites "a pre-event handler that processes an editing event," and Claim 29  
3       recites "an edit designer interface that includes a pre-handle event method to  
4       process an event before the default event handler processes the event." Various  
5       exemplary editing events are set forth in the specification, such as a key stroke or  
6       combination of key strokes received from a user. How then are Claims 1, 23, and  
7       29 drawn solely to a law of nature, natural phenomenon, or abstract idea when  
8       they recite elements capable of processing an editing event?

9       Claim 34 recites "a pre-handle event method used to send an editing event  
10      to a designer." This element of Claim 34 is used to send an editing event, such as  
11      a keystroke, to a designer. Neither a law of nature, nor a natural phenomenon, nor  
12      an abstract idea can send a keystroke to a designer. How then can Claim 34 be a  
13      law of nature, natural phenomenon, or abstract idea?

14      For each of Claims 1-7 and 23-37, the Office has failed to show that the  
15      recited elements fall within the mathematical subject matter exception of §101.  
16      For this and the other reasons set forth above, Applicant respectfully submits that  
17      Claims 1-7 and 23-37 comply with 35 U.S.C. §101 and requests that the §101  
18      rejections be withdrawn.

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20      The §103 Rejections

21      Claims 1-3, 23-29, 31-34, and 36-37 stand rejected under 35 U.S.C.  
22      §103(a) as being unpatentable over Applicant's own admitted prior art in the  
23      background of the invention in view of U.S. Patent No. 5,771,384 to Remington et  
24      al. (hereinafter, "Remington").

1       Applicant submits that the Office has failed to establish a *prima facie* case  
 2 of obviousness and, in view of the comments below, respectfully traverses the  
 3 Office's rejections. Before discussing the substance of the Office's rejections,  
 4 however, a section entitled "The §103 Standard" is provided and will be used in  
 5 addressing the Office's rejections. Following this section, a section entitled "The  
 6 Remington Reference" is provided, which describes Remington's disclosure and  
 7 teachings.

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### The §103 Standard

10     To establish a *prima facie* case of obviousness, three basic criteria *must* be  
 11 met. First, there must be some suggestion or motivation, either in the references  
 12 themselves or in the knowledge generally available to one of ordinary skill in the  
 13 art, to modify the reference or to combine reference teachings. *In re Jones*, 958  
 14 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5  
 15 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation  
 16 of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.  
 17 1986). Finally, the prior art reference (or references when combined) must teach  
 18 or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580  
 19 (CCPA 1974).

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1 reason the skilled artisan, with no knowledge of the claimed invention, would have  
 2 selected these components for combination in the manner claimed").

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4 **The Remington Reference**

5 Generally, Remington directs his disclosure and invention to mechanisms  
 6 for storing information in a computer system. *See Remington*, column 4, lines 18-  
 7 21 and Abstract. In the Summary of the Invention section, Remington provides  
 8 additional detail about his invention, stating that it relates to data processing  
 9 systems and, more particularly, to the programmability of containers within data  
 10 processing systems. *Remington*, column 3, lines 35-51.

11 In providing examples of his invention, Remington states that an "event" is  
 12 a message generated by a container to apprise another entity that a specific event  
 13 occurred. *Remington*, column 8, lines 39-40. Remington continues, stating that  
 14 "[e]vents are associated with the adding and removing of items from a container."  
*Remington*, column 9, lines 11-12. And that an "event handler is invoked every  
 16 time that an item is attempted to be moved or copied into [a] container."  
*Remington*, column 15, lines 24-27.

18 Thus, the focus of Remington's disclosure is storing information in  
 19 containers.

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21 **Response to the §103 Rejections**

22 Preliminarily, in making out the rejection of Claims 1-7 and 23-37, the  
 23 Office argues the Remington reference and uses language that does not appear in  
 24 these claims. To the extent that the terminology utilized by the Office in making  
 25 out these rejections varies from the specific claim language that appears in these

1 claims, Applicant respectfully submits that the Office has improperly addressed  
2 these claims.

3 For the Office's convenience, Applicant sets forth the language of  
4 independent Claim 1, followed by the Office's reasoning in rejecting Claim 1.

5 Claim 1 recites an electronic document editor, comprising:

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- 7 • a default event handler to process editing events;
- 8 • a designer extensibility mechanism to communicate with an extension coupled with the editor, the extension being configured to process at least one of the editing events; and
- 9 • wherein the designer extensibility mechanism provides the editing events to the extension prior to the default event handler processing the editing events.

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11 The Office's reasoning:

12 Regarding claims 1, 2, 3, 23, 24, 25, 29, 33, 34 and 37,  
13 applicant's own admitted prior art teaches a extensible document editor with event handler, wherein the extension is coupled to editor and the extension is configured to process editing events as described in the instant specification page 1, lines 7-page 2, line 17.

14

15 Applicant's own admitted art fails to teach extensibility mechanism providing the editing events to the extension prior to the default event handler processing the editing events. Remington et al do. Specifically, Remington et al. teaches the extension functionality as described in col. 4, lines 30-32. Event handlers are described in col. 4, lines 66-col. 5, lines 2. Providing the events to extension through pre-event and post-event processing prior to default processing is described in col. 9, lines 10-15.

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17 Therefore it would have been obvious to a person with ordinary skill in the art at the time the invention was made to implement event handling technique of Remington et al in the editor of applicant's own admitted prior art because it provides added flexibility for document editing over default processing.

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19 Regarding claim 26, 27, 28, 31, Remington teaches a communication between event handler and default processing to continue processing or editing as described in col. 15, lines 25-36. Pre-event processing and post-event processing is described in col. 9, lines 10-15. Since the editor executes various commands, it is

1 obvious that the command is translated for it to be processed. It  
2 would have been obvious for a person of ordinary skill in the art at  
3 the time the invention was made to incorporate communication  
4 between event handlers and default processors because it aids in  
5 processing user desirable actions when requested.

6 Regarding claims 32 and 36, Remington teaches the  
7 claimed invention of event ID, i.e. event address as described in  
8 col. 14, lines 55-60.

9 *Office Action, pages 3-4.*

10 Applicant submits that the Office has failed to establish a *prima facie* case  
11 of obviousness in rejecting Claim 1 by failing to establish that each and every  
12 element of Claim 1 is taught or suggested by the references. *See In re Royka,*  
13 *supra.*

14 First, the Office argues that "applicant's own admitted prior art teaches a  
15 extensible document editor with event handler", citing "the instant specification  
16 page 1, lines 7-page 2, line 17" in support. A careful reading of the cited portion  
17 of Applicant's specification reveals that an "event handler" is not disclosed. For at  
18 least this reason, the Office has failed to establish a *prima facie* case of  
19 obviousness in rejecting claim 1.

20 Second, the Office argues that Remington teaches "extension functionality"  
21 in column 4, lines 30-32. Presumably the Office intends these terms to mean  
22 elements recited in Claim 1, though in what manner the Office does not illuminate.

23 The Office's sole support for its argument that "extension functionality" is  
24 taught by Remington is:

25 ... replacement of the implementation of the interface of the  
26 container ("replaceability") and by allowing for the extension of the  
27 functionality provided by the interface...

28 *Remington, column 4, lines 30-32.*

1 Remington has not been shown by the Office to teach "extension  
2 functionality" relating to "designer extensibility mechanism to communicate with  
3 an extension coupled with the editor, the extension being configured to process at  
4 least one of the editing events", as required by Claim 1. Also, this quotation is  
5 referring to containers, not editors. The Office has not shown why a container  
6 teaches an editor.

7 Third, the Office's sole support for its argument that "[p]roviding the  
8 events to extension through pre-event and post-event processing prior to default  
9 processing" is taught by Remington is:

10 Events are associated with the adding and removing of items from a  
11 container. The events allow the entity that is apprised of an event to  
12 perform pre-event and post-event processing, cancel the event, and  
13 suppress the default container functionality.

14 *Remington, column 9, lines 10-15.*

15 The Office has not shown how this quotation teaches a default event  
16 handler to process editing events, as required by Claim 1.

17 Also, this and the other portions of Remington relied on by the Office are  
18 related to events as the term is used in Remington. But the events of Remington  
19 are not the editing events recited in Claim 1. As set forth in the Remington  
20 Reference section above, Remington states that an "event" is a message generated  
21 by a container to apprise another entity that a specific event occurred. *Remington,*  
22 column 8, lines 39-40. Remington also states that "[e]vents are associated with  
23 the adding and removing of items from a container." *Remington, column 9, lines*

1 11-12. In both of these examples, the events of Remington do not teach an  
 2 "editing event" as required by Claim 1.

3 The Office's relied-on support for its rejection may be illustrated by  
 4 replacing the Office's argued elements with those of Claim 1. Following the  
 5 Office's argument, Claim 1 may look like this:

6  
 7 An electronic document editor, comprising:

- 8 • a default event handler to process editing events associated with the adding  
and removing of items from a container;
- 9 • a designer extensibility mechanism extension functionality to communicate  
 10 with an extension coupled with the editor, the extension functionality being  
 11 configured to process at least one of the editing event associated with the  
adding and removing of items from the container; and
- 12 • wherein the designer extensibility mechanism extension functionality  
 13 provides the editing events associated with the adding and removing of  
items from a container to the extension prior to the default event handler  
 14 processing the editing events associated with the adding and removing of  
items from a container.

15 As is apparent from this illustration, no relationship between the  
 16 "container" of Remington and the "editor" required by Claim 1 has been shown.  
 17 No relationship between "events associated with the adding and removing of items  
 18 from a container" of Remington and the "editing events" required by Claim 1 has  
 19 been shown. No relationship between the "extension functionality" of Remington  
 20 and the "designer extensibility mechanism" required by Claim 1 has been shown.  
 21 The Office has failed to establish that each and every element of Claim 1 is taught  
 22 or suggested by the references.

23 Applicant also submits that the Office has failed to establish a *prima facie*  
 24 case of obviousness in rejecting Claim 1 by failing to provide sufficient reasoning

1 for combining Applicant's disclosure and Remington. The Office argues that "it  
2 would have been obvious to a person with ordinary skill in the art at the time the  
3 invention was made to implement event handling technique of Remington et al in  
4 the editor of applicant's own admitted prior art because it provides added  
5 flexibility for document editing over default processing." *Office Action*, page 3.

6 Remington's disclosure, as described above, is directed to mechanisms for  
7 storing information in a computer system. The Office has not shown why one  
8 skilled in the art at the time the invention was made would have been motivated to  
9 combine a disclosure directed to storing information in a computer system with the  
10 application's disclosure in the Background section. The Office argues that "it  
11 would have been obvious ... to implement event handling technique of Remington  
12 et al in the editor of applicant's own admitted prior art because it provides added  
13 flexibility for document editing over default processing." To meet the  
14 requirements of the law, this argument must show that there is a suggestion or  
15 motivation, either in the references themselves or in the knowledge generally  
16 available to one of ordinary skill in the art, to modify the reference or to combine  
17 reference teachings. *See In re Jones, supra*. The Office must also provide—with  
18 specificity—evidence relevant to the finding of whether there is a teaching,  
19 motivation, or suggestion to select and combine or modify the references relied on  
20 as evidence of obviousness. *See In re Kotzab, supra*.

21 On its face, the Office's argument fails to establish with particularity a  
22 suggestion or motivation to modify the application's disclosure.

23 Adding to this the general teaching of Remington focusing his disclosure  
24 on storing information in a computer system, the Office's argument is further  
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1 insufficient to overcome the teaching of Remington in contravention to combining  
2 Remington with Applicant's background section.

3 For any one of the many reasons set forth above, the Office has failed to  
4 establish a *prima facie* case of obviousness in rejecting Claim 1. Applicant  
5 respectfully requests that the Office withdraw the rejection of Claim 1.

6 **Claims 2-3** depend from Claim 1 and are allowable as depending from an  
7 allowable base claim. These claims are also allowable for their own recited  
8 features that, in combination with those recited in Claim 1, are neither disclosed  
9 nor suggested in references of record, either singly or in combination with one  
10 another.

11 For the Office's convenience, Applicant sets forth the language of  
12 independent Claim 23, followed by the Office's reasoning in rejecting Claim 23.

13 **Claim 23** recites a designer attached to an editor, comprising a pre-event  
14 handler that processes an editing event from the editor before the editor processes  
15 the event.

16 The Office's reasoning:

17 Regarding claims 1, 2, 3, 23, 24, 25, 29, 33, 34 and 37,  
18 applicant's own admitted prior art teaches a extensible document  
19 editor with event handler, wherein the extension is coupled to  
editor and the extension is configured to process editing events as  
described in the instant specification page 1, lines 7-page 2, line  
17.

20 Applicant's own admitted art fails to teach extensibility  
21 mechanism providing the editing events to the extension prior to  
the default event handler processing the editing events. Remington  
et al do. Specifically, Remington et al. teaches the extension  
functionality as described in col. 4, lines 30-32. Event handlers are  
described in col. 4, lines 66-col. 5, lines 2. Providing the events to  
extension through pre-event and post-event processing prior to  
default processing is described in col. 9, lines 10-15.  
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1           Therefore it would have been obvious to a person with  
2 ordinary skill in the art at the time the invention was made to  
3 implement event handling technique of Remington et al in the  
4 editor of applicant's own admitted prior art because it provides  
5 added flexibility for document editing over default processing.

6           *Office Action, page 3.*

7           Applicant submits that the Office has failed to establish a *prima facie* case  
8 of obviousness in rejecting Claim 23 by failing to establish that each and every  
9 element of Claim 23 is taught or suggested by the references. *See In re Royka,*  
10 *supra.*

11           First, the Office argues that "applicant's own admitted prior art teaches a  
12 extensible document editor with event handler", citing "the instant specification  
13 page 1, lines 7-page 2, line 17" in support. The Office's argument does not  
14 establish, on its face, that Applicant's Background teaches a "pre-event handler"  
15 as required by Claim 23. The Office's argument does not even mention a "pre-  
16 event handler." For at least this reason the Office has failed to establish a *prima*  
17 *facie* case of obviousness.

18           Second, the Office argues that Remington teaches "[e]vent handlers" in col.  
19 4, lines 66-col. 5, lines 2, and "[p]roviding the events to extension through pre-  
20 event and post-event processing prior to default processing" in col. 9, lines 10-15.  
21 Applicant assumes that the Office intends these terms to mean elements recited in  
22 Claim 23, though the Office has not established in what way the Office intends  
23 these to apply to the elements recited in Claim 23.

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1       The Office's sole support for its argument that "[p]roviding the events to  
2 extension through pre-event and post-event processing prior to default processing"  
3 is taught by Remington is:

4       Events are associated with the adding and removing of items from a  
5 container. The events allow the entity that is apprised of an event to  
6 perform pre-event and post-event processing, cancel the event, and  
suppress the default container functionality.

7       *Remington, column 9, lines 10-15.*

8

9       As set forth in Applicant's reasoning with regard to Claim 1 above, the  
10 Office has not shown how this quotation teaches an editing event, as required by  
11 Claim 23. For either of these reasons, the Office has failed to establish that each  
12 and every element of Claim 23 is taught or suggested by the references.

13       Applicant also submits that the Office has failed to establish a *prima facie*  
14 case of obviousness in rejecting Claim 23 by failing to provide sufficient  
15 reasoning for combining Applicant's disclosure and Remington for the reasons set  
16 forth Applicant's argument in response to the Office's rejection of Claim 1 under  
17 §103.

18       For any one of the many reasons set forth above, the Office has failed to  
19 establish a *prima facie* case of obviousness in rejecting Claim 23. Applicant  
20 respectfully requests that the Office withdraw the rejection of Claim 23.

21       **Claims 24-28** depend from Claim 23 and are allowable as depending from  
22 an allowable base claim. These claims are also allowable for their own recited  
23 features that, in combination with those recited in Claim 23, are neither disclosed  
24

1 nor suggested in references of record, either singly or in combination with one  
2 another.

3 For the Office's convenience, Applicant sets forth the language of  
4 independent Claim 29, followed by the Office's reasoning in rejecting Claim 29.

5 Claim 29 recites an editor that communicates with a first designer and a  
6 second designer, comprising:

- 7 • a default event handler; and
- 8 • an edit designer interface that includes a pre-handle event method to  
process an event before the default event handler processes the event,  
and a post-handle event method to process the event after the default  
event handler has processed the event.

9  
10 The Office's reasoning:

11 Regarding claims 1, 2, 3, 23, 24, 25, 29, 33, 34 and 37,  
12 applicant's own admitted prior art teaches a extensible document  
13 editor with event handler, wherein the extension is coupled to  
14 editor and the extension is configured to process editing events as  
15 described in the instant specification page 1, lines 7-page 2, line  
16 17.

17 Applicant's own admitted art fails to teach extensibility  
18 mechanism providing the editing events to the extension prior to  
the default event handler processing the editing events. Remington  
19 et al do. Specifically, Remington et al. teaches the extension  
20 functionality as described in col. 4, lines 30-32. Event handlers are  
21 described in col. 4, lines 66-col. 5, lines 2. Providing the events to  
22 extension through pre-event and post-event processing prior to  
23 default processing is described in col. 9, lines 10-15.

24 Therefore it would have been obvious to a person with  
ordinary skill in the art at the time the invention was made to  
implement event handling technique of Remington et al in the  
editor of applicant's own admitted prior art because it provides  
added flexibility for document editing over default processing.

25  
26 *Office Action, page 3.*

27  
28 Applicant submits that the Office has failed to establish a *prima facie* case  
29 of obviousness in rejecting Claim 29 by failing to establish that each and every

1 element of Claim 29 is taught or suggested by the references as required by *In re*  
2 *Royka, supra.*

3 For the reasons set forth above, Applicant asserts that the Office's argument  
4 does not establish, on its face, that Applicant's Background teaches a "default pre-  
5 event handler" as required by Claim 29. The cited portion of Applicant's  
6 specification relied on by the Office does not disclose a "default event handler."  
7 For either of these reasons, the Office has failed to establish a *prima facie* case of  
8 obviousness in rejecting claim 29.

9 Second, the Office argues that Remington teaches "[p]roviding the events  
10 to extension through pre-event and post-event processing prior to default  
11 processing" in col. 9, lines 10-15.

12 As set forth in Applicant's reasoning with regard to Claim 1 above, the  
13 Office has not shown how this quotation teaches an event as required by Claim 29.  
14 For either of these reasons, the Office has failed to establish that each and every  
15 element of Claim 29 is taught or suggested by the references.

16 Applicant also submits that the Office has failed to establish a *prima facie*  
17 case of obviousness in rejecting Claim 29 by failing to provide sufficient  
18 reasoning for combining Applicant's disclosure and Remington for the reasons set  
19 forth in Applicant's argument in response to the Office's rejection of Claim 1  
20 under §103.

21 For any one of the many reasons set forth above, the Office has failed to  
22 establish a *prima facie* case of obviousness in rejecting Claim 29. Applicant  
23 respectfully requests that the Office withdraw the rejection of Claim 29.

1       Claims 31-33 depend from Claim 29 and are allowable as depending from  
2 an allowable base claim. These claims are also allowable for their own recited  
3 features that, in combination with those recited in Claim 29, are neither disclosed  
4 nor suggested in references of record, either singly or in combination with one  
5 another.

6       For the Office's convenience, Applicant sets forth the language of  
7 independent Claim 34, followed by the Office's reasoning in rejecting Claim 34.

8       Claim 34 recites an edit designer interface in an extensible editor,  
9 comprising:

- 10      • a pre-handle event method used to send an editing event to a  
11        designer attached to the editor prior to the editor processing the  
12        editing event; and
- 13      • a post-handle event method used to send the editing event to the  
14        designer after the editor has processed the editing event.

15       The Office's reasoning:

16       Regarding claims 1, 2, 3, 23, 24, 25, 29, 33, 34 and 37,  
17       applicant's own admitted prior art teaches a extensible document  
18       editor with event handler, wherein the extension is coupled to  
19       editor and the extension is configured to process editing events as  
20       described in the instant specification page 1, lines 7-page 2, line  
21       17.

22       Applicant's own admitted art fails to teach extensibility  
23       mechanism providing the editing events to the extension prior to  
24       the default event handler processing the editing events. Remington  
25       et al do. Specifically, Remington et al. teaches the extension  
      functionality as described in col. 4, lines 30-32. Event handlers are  
      described in col. 4, lines 66-col. 5, lines 2. Providing the events to  
      extension through pre-event and post-event processing prior to  
      default processing is described in col. 9, lines 10-15.

26       Therefore it would have been obvious to a person with  
27       ordinary skill in the art at the time the invention was made to  
28       implement event handling technique of Remington et al in the  
29       editor of applicant's own admitted prior art because it provides  
      added flexibility for document editing over default processing.

30       *Office Action, page 3.*

1       Applicant submits that the Office has failed to establish a *prima facie* case  
2 of obviousness in rejecting Claim 34 by failing to establish that each and every  
3 element of Claim 34 is taught or suggested by the references. *See In re Royka,*  
4 *supra.*

5       For the reasons set forth above, the Office has failed to establish a *prima*  
6 *facie* case of obviousness by: 1) the Office failing to establish why the "container"  
7 of Remington is interchangeable with or teaches the "editor" required by Claim  
8 34; 2) the Office failing to establish why the events of Remington teach the editing  
9 events required by Claim 34; and 3) the Office failing to provide sufficient  
10 reasoning for combining Applicant's disclosure and Remington in contravention  
11 to Remington being directed to storing information in a computer system.

12      For any one of these reasons, the Office has failed to establish a *prima facie*  
13 case of obviousness in rejecting Claim 34. Applicant respectfully requests that the  
14 Office withdraw the rejection of Claim 34.

15      **Claims 36-37 depend from Claim 34 and are allowable as depending from**  
16 **an allowable base claim. These claims are also allowable for their own recited**  
17 **features that, in combination with those recited in Claim 34, are neither disclosed**  
18 **nor suggested in references of record, either singly or in combination with one**  
19 **another.**

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1      **Conclusion**

2      All pending claims are in condition for allowance. Applicant respectfully  
3      requests reconsideration and prompt issuance of the present application. Should  
4      any issue remain that prevents immediate issuance of the application, the  
5      Examiner is encouraged to contact the undersigned attorney to discuss the  
6      unresolved issue.

7

8

9      Respectfully Submitted,

10     Dated: 3 June 05

11     By:

*Michael K. Colby*

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